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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/829,542

04/22/2004

John C. Martin

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EXAMINER

GROSSO, HARRY A

ART UNIT

PAPER NUMBER

3781

MAIL DATE

DELIVERY MODE

05/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/829,542

Applicant(s)

MARTIN, JOHN C.

Examiner

Harry A. Grosso

Art Unit

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 15-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/13/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to a container, classified in class 220, subclass 576.
- II. Claim 15, drawn to a smoker, classified in class 99, subclass 482.
- III. Claims 16-23, drawn to a method, classified in class 426, subclass 423.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because there is no mention of a lid and aperture. The subcombination has separate utility such as container for other materials.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such

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claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process of using the product, such as one not requiring the draining of liquid.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different modes of operation.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

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Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention

During a telephone conversation with Jeffrey Sadowski on 13 February 2007 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant's election with traverse of Claims 1-14 in the reply filed on April 20, 2007 is acknowledged. The traversal is on the ground(s) that claim 15 is directed at a container such as that in claims 1-14 and that the method of claims 16-23 can be performed by the container of claims 1-14. This is not found persuasive because while the container of claims 1-14 could be used in the combination of claim 15, claim 15 does not require the container of claims 1-14 and the container of claims 1-14 has separate utility for use with other materials. The method of claims 16-23 does not require the container of claims 1-14 and the container can be used with materials that do not require draining. In addition, the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries).

The requirement is still deemed proper and is therefore made FINAL.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be **material to patentability** as defined in 37 CFR 1.56. The declaration, as filed, references information which is "**material to the examination**" of the application and Section 37 CFR 1.56(a).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim recites the limitation of one person draining the container using only one hand. This is not described in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the limitation of one person draining the container using only one hand. This is not described in the specification and it is unclear what is intended.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Faris (2,539,412)

3. Regarding claims 1 and 6, Faris discloses an apparatus capable of being used to soak wood chips or chunks with a sidewall (19, Figures 1, 2 and 4), a bottom (21) and a removable lid (29) with holes (37).

4. Regarding claim 2, the apparatus includes a means for retaining the fluid entirely within the container, the sidewall and bottom.

5. Regarding claim 3, the apparatus includes a means to permit liquid to pass into the container when it is immersed, the holes (37) in the lid.

6. Regarding claim 4, the wood chips or chunks are totally submerged after addition of the soaking fluid because the lid is recessed to extend below the top of the liquid containing body.

7. Regarding claim 5, the apparatus has a handle (17) and it can be drained by one person grasping the handle and laying the apparatus over on its side.

8. Regarding claim 8, the container is adapted to contain the liquid while the wood chips or chunks are soaking.

9. Claims 6, 9, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hwang (5,992,673)

10. Regarding claim 6, Hwang discloses an apparatus capable of being used to soak wood chips or chunks with a container having a sidewall and a bottom surface (Figures 3-6) and a removable lid (30) having at least one aperture.

11. Regarding claim 9, the sidewall has at least one aperture.

12. Regarding claim 10, the bottom has at least one aperture.

13. Regarding claim 11 Hwang discloses legs (96) connected to the bottom of the container and a projection (102) on the bottom surface of the container.

14. Claims 6, 7, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (913,532).

15. Regarding claim 6, Miller discloses an apparatus capable of being used to soak wood chips or chunks with a container (Figures 4 and 5) having a sidewall (4) and a bottom surface (5) and a removable lid (10, Figure 5) with at least one aperture.

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16. Regarding claim 7, the container is constructed from heat-resistant material (metal, page 1, lines 60-61) and is adapted for use with a heat source (page 1, lines 80-87).
17. Regarding claim 9, the container sidewall has at least one aperture.
18. Regarding claim 10, the bottom has at least one aperture (5).
19. Claims 6, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Stolzman (6,056,143)
20. Regarding claim 6, Stolzman discloses an apparatus capable of being used to soak wood chips or chunks with a container (12, Figure 1) and a removable lid (14) having at least one aperture visible in Figure 1 and in Figure 4.
21. Regarding claim 13, the container has threads (30, Figure 3)
22. Regarding claim 14, the lid has a lip (54) for engaging the threads.
23. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Lagorio (1,948,353) Lagorio discloses an apparatus capable of being used to soak wood chips or chunks with a container (Figures 1 and 3) and a removable lid (11) having at least one aperture (5).

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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25. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lagorio in view of Fisher (750,632). Lagorio discloses the invention of claim 6 and further discloses a plurality of horizontal grooves (12, Figure 3) and tabs (15) used to lock the lid in position. Lagorio does not teach the tabs being attached to the lid or vertical grooves in which the tabs can slide. Fisher discloses an adjustable volume container in which the movable top section (lid) has tabs attached that move in vertical grooves in the container and engage horizontal grooves to change the vertical height of the container top (Figures 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the concept of tabs attached to the adjustable top section (lid) and vertical grooves for movement of the tabs as disclosed by Fisher in the apparatus disclosed by Lagorio to allow adjustment of the height of the lid with the tabs attached as part of the lid eliminating the need for separate tabs which require an extra operation to lock in the lid and which can be misplaced.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry A. Grosso whose telephone number is 571-272-4539. The examiner can normally be reached on Monday through Thursday from 7am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Anthony Stashick
Supervisory Patent Examiner
Art Unit 3781

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